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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Smith, S.

Examiner: Isabella, D.

Application No.: 10/630,562

Group Art Unit: 3738

Filed: July 30, 2003

Docket: 760-12 DIV/CON

For: **HELICALLY FORMED
STENT/GRAFT ASSEMBLY**

Dated: March 28, 2005

Confirmation No.: 8643

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to: Commissioner for Patents, Alexandria, VA 22313

Dated: March 28, 2005

Signature: Barbara Thomas

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
PURSUANT TO 37 C.F.R. §1.181(a)**

Sir:

In response to the Notice of Abandonment mailed on February 1, 2005, petition is hereby made to withdraw the holding of abandonment. The following information is tendered in support of the subject petition.

Enclosed as Exhibit A is a copy of the Notice of Abandonment mailed on February 1, 2005. The enclosed Notice of Abandonment indicates that the subject application was abandoned under 37 C.F.R. §1.111 for allegedly not providing a Petition for an Extension of Time with the corresponding fee pursuant to 37 C.F.R. §1.17.

Attorney for the applicant respectfully submits that a Petition for Extension of Time was not required, and petitions the Office to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181(a).

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On July 8, 2004, a non-final Office Action was mailed by the Office. A copy of the non-final Office Action is provided herewith as Exhibit B. The Office Action set a three-month reply date with extensions of time for a total of three additional months being available.

On October 7, 2004, a Reply to the Office Action was mailed to the Patent Office. The Reply was certified as to being deposited with the United States Postal Service as first class mail pursuant to 37 C.F.R. §7.8. The return postcard corresponding to this Reply indicates that the Reply was received by the Office on October 12, 2004. A copy of the Reply as filed and a copy of the return postcard is provided as Exhibit C.

On October 22, 2004, the Office mailed a Notice of Non-Compliant Amendment, a copy of which is attached as Exhibit D. The Notice indicated that the Reply of October 7, 2004 was non-compliant as being unsigned. The Notice provided a reply period of one-month pursuant to 37 C.F.R. §1.135(c).

On October 28, 2004, a Response to Notice of Non-Compliant Amendment was filed by attorney of record and certified as being deposited with the United States Patent Office as first class mail pursuant to 37 C.F.R. §1.8. The Response correctly included the required signature. A copy of this Response is attached as Exhibit E.

On February 1, 2005, the above-mentioned Notice of Abandonment was mailed by the Office.

For the reasons discussed below, Attorney for the applicant petitions for withdrawal of the Notice of Abandonment as the Response to the Notice of Non-Compliant Amendment was timely filed and did not require a petition for an extension of time and associated fee.

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The Notice of Non-Compliant Amendment indicated that the unsigned amendment (the Reply of October 7, 2004) was *bona fide* attempt to be a reply pursuant to 37 C.F.R. §1.135(c). Accordingly, the Notice of Non-Compliant Amendment provided a time period of one month to re-submit the corrected section of the amendment. Such a reply was filed within the specified one-month period and the Examiner entered the reply providing the required signature.

As the Reply to the Notice of Non-Complaint Amendment was timely filed, i.e., within the one month period, no extensions of time were required because, as ruled by the Office, the October 7, 2004 Reply was a *bona fide* attempt to provide a response to a non-final Office Action.

The Examiner apparently incorrectly applied the requirement for an extension of time in the subject case. As noted above, the Notice of Non-Compliant Amendments sets a one-month reply period for a non-final office action when the non-compliant amendment is ruled a *bona fide* attempt to a reply by the Office. When a one-month reply period is not provided in such a notice, the Examiner must notify the Applicant that an omission to the previous reply must be supplied within the period reply must be supplied within the period to the prior action and must include any extension of time relating back to that prior office action. Such policy is clearly set forth in the MPEP under Section 710.01.

As the Notice of Non-Compliant Amendment clearly stated that a one-month reply had been set, an extension of time was not required because the Reply was filed within the one-month time period set forth in the Notice of Non-Compliant Amendment. MPEP Section 710.01 clearly states that the one-month reply period for a non-final office action does not apply only when the previous response was not a *bona fide* attempt. As the previous Reply in this case has been ruled as a *bona fide* attempt, the one-month reply period must be applied in this case.

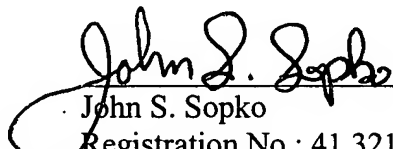
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Thus, Applicants petition the Office for withdrawal of the holding of abandonment and that prosecution on the subject case continues on the merits.

Based upon the showing provided herein, the undersigned counsel respectfully request the holding of abandonment of the subject application be withdrawn. Since this petition is made under 37 C.F.R. §1.181(a) requesting withdrawal of the holding of abandonment, no petition fee is required. If a petition fee is required, however, the Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. §1.17 and should be treated as a constructive petition for an extension of time in this communication or any future communication pursuant to 37 C.F.R. §1.136.

Please direct any questions or telephone calls regarding this petition to the undersigned counsel at the telephone number listed below.

Respectfully submitted,


John S. Sopko
Registration No.: 41,321
Attorney for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,562	07/30/2003	Scott Smith	760-12 DIV/CON	8643

23869 7590 02/01/2005

HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

EXAMINER

ISABELLA, DAVID J

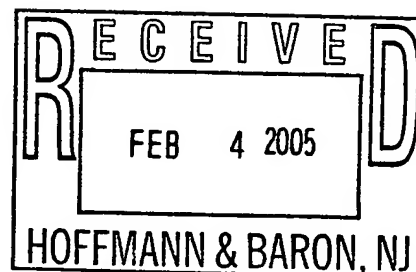
ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/01/2005

FEB - 3 2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Notice of Abandonment

Application No.

10/630,562

Examiner

DAVID J ISABELLA

Applicant(s)

SMITH, SCOTT

Art Unit


3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 08 July 2004.
 - (a) ☒ A reply was received on 01 November 2004 (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on 08 October 2004.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ A reply was received on 22 October 2004 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

APPLICANT FAILED TO PROVIDE A PETITION FOR AN EXTENSION OF TIME ALONG WITH THE APPROPRIATE FEES UNDER 1.17.


DAVID J ISABELLA
Primary Examiner
Art Unit: 3738

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



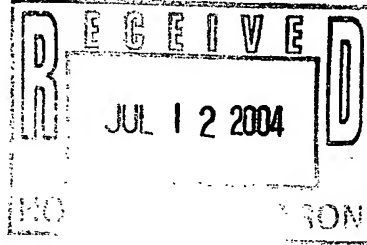
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,562	07/30/2003	Scott Smith	760-12 DIV/CON	8643

23869 7590 07/08/2004

HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791



EXAMINER

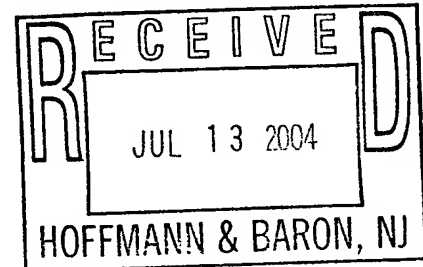
ISABELLA, DAVID J

ART UNIT PAPER NUMBER

3738

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

10/630,562

Applicant(s)

SMITH, SCOTT

Examiner

DAVID J ISABELLA

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4,5,8,9,11,12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Hieshima, et al (6063111).

A stent/graft composite device formed from a flat preformed planar strip and stent assembly comprising: an elongate preformed non-textile planar strip of polymeric graft material having first and second opposed surfaces and a planar stent attached onto one of said opposed flat surfaces of said strip to form said flat strip assembly, said strip assembly being helically wound into a continuous tubular structure. A stent/graft composite device (Figure 2A) formed from a flat preformed planar strip (30,32) and stent assembly (10a) comprising: an elongate preformed non-textile planar strip of polymeric graft material having first and second opposed surfaces and a planar stent attached onto one of said opposed flat surfaces of said strip to form said flat strip assembly, said strip assembly being helically wound into a continuous tubular structure is disclosed by Hieshima, et al.

Claim 2, see column 4, lines 25+ for teaching of overlap.

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Claim 4, see planar strips 30 and 32.

Claim 5, the stent is sealed between the two planar strips (column 4, lines 15+.).

Claim 8, see figure 2A.

Claim 9, see plurality of stent wires in figure 11 and supporting specification column 6, lines 30+.

Claim 11, see column 3, lines 25+.

Claims 12 and 13, see figure 1A. It is not clear how what structural characteristics distinguishes a planar wire from a planar ribbon.

Claims 1,2,4,5,8,9,11,12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin et al (6042605).

A stent/graft composite device formed from a flat preformed planar strip (8) and stent assembly comprising: an elongate preformed non-textile planar strip of polymeric graft material having first and second opposed surfaces and a planar stent (6) attached onto one of said opposed flat surfaces of said strip to form said flat strip assembly, said strip assembly being helically wound into a continuous tubular structure is disclosed by Martin, et al.

Claim 3, the helical windings do not overlap.

Claims 6 and 7, see column 14, lines 5+.

Claim 8, see tubular structure shown in figure 1A.

Claim 9, see plurality of stent wires in the figures.

Claim 10, see linking of the stent wires in the figures.

Claim 11, see column 13, lines 15+.

Claims 1-9, 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Banas et al (6264684).

A stent/graft composite device formed from a flat preformed planar strip (36) and stent assembly comprising: an elongate preformed non-textile planar strip of polymeric graft material having first and second opposed surfaces and a planar stent (38) attached onto one of said opposed flat surfaces of said strip to form said flat strip assembly, said strip assembly being helically wound into a continuous tubular structure is disclosed by Martin, et al.

Claim 2, see figure 13 for teaching of overlap.

Claim 3, see figures 1 and 4B for teaching of non-overlap.

Claims 6 and 7, see column 4, lines 40+.

Claim 8, see figures for tubular shape.

Claim 11, see column 3, lines 13+.

Claim 12-13, see appropriate embodiments shown in figures 5-12.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone

Notice of References Cited

Application/Control No.

10/630,562

Applicant(s)/Patent Under
Reexamination
SMITH, SCOTT

Examiner

DAVID J ISABELLA

Art Unit

3738

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,824,053	10-1998	Khosravi et al.	623/1.15
	B	US-6,042,605	03-2000	Martin et al.	623/1.13
	C	US-6,063,111	05-2000	Hieshima et al.	623/1.22
	D	US-6,156,062	12-2000	McGuinness, Colm P.	623/1.22
	E	US-6,264,684	07-2001	Banas et al.	623/1.13
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.